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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,626	06/09/1999	STEVEN A. BOVE	245-111	7062

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AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
ONE COMMERCE SQUARE, SUITE 2200
2005 MARKET STREET
PHILADELPHIA, PA 19103

EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/328,626

Applicant(s)

Bove et al

Examiner

Daniel Felten

Art Unit

3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 19, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 13-21, 23-25, 27-50, 52-54, and 56-62 is/are rejected.
- 7) ☒ Claim(s) 8, 12, 22, 26, 51, and 55 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

- 1
2 1. Receipt of the Response to the Office Action mailed June 4, 2002 is acknowledged.
3
4

5 ***Claim Rejections - 35 USC § 112***

- 6 2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

7 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
8 subject matter which the applicant regards as his invention.

- 9 3. Claims 8, 12, 22, 26, 37, 55 and 57 are rejected under 35 U.S.C. 112, second
10 paragraph, as being indefinite for failing to particularly point out and distinctly claim the
11 subject matter which applicant regards as the invention.
12

13 **Regarding claims 12, 26, 37 and 51:**

14 It is unclear from the claim exactly what an Ibbotson score is or how it is being used
15 within the aforementioned claims.
16
17
18

1 **Regarding claims 8, 22, 41 and 55:**

2 the limitation of "about 3%" as it is cited in the aforementioned claims is ambiguous
3 because the word "about" connotes a percentage *range* which is unspecified by the claim. For
4 example, "about 3%" could mean anywhere within a range of 3%.

5
6
7
8 ***Claim Rejections - 35 USC § 103***

9 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
10 obviousness rejections set forth in this Office action:

11 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
12 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
13 are such that the subject matter as a whole would have been obvious at the time the invention was made to a
14 person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
15 negated by the manner in which the invention was made.

16
17 5. Claims 1-7, 9-11, 13-21, 23-25 and 27-29 are rejected under 35 U.S.C. 103(a) as being
18 unpatentable over Edesess (US 5,884, 287) in view of Alden (US 5,418,888).

19 **Regarding claims 1 and 15:**

20 Edesess discloses a computerized process and product for automating and executing
21 investment planning for a client comprising:

1 (a) inputting into a computer data regarding the client's desired asset portfolio(see
2 Edesess, col. 4, ll. 27-30; col. 39, ll. 47-50; col. 5, ll. 15-19) , as in

3 (b)...desired allocation (see Edesess, col. 4, ll. 45-55; col. 5, ll. 15-22),

4 (c)... preferred domain (see Edesess, col. 5, ll. 38)

5 (d)...to automatically generate financial transaction recommendations for modifying the
6 clients current asset portfolio to reach as close as possible to the desired asset allocation and
7 preferred domain (see Edesess, fig. 6, "*Contributions should be increased and/or expenditures*
8 *reduced when in this zone.*")

9 (e) displaying the recommendations on a summary report for review by the client or
10 the client's financial manager (see Edesess, figs. 4-6; col. 6, ll. 33+)

11 Edesess fails to disclose recommendations for selling amounts of selected current assets
12 and specific recommendations for buying amounts of one or more investment funds.

13 Alden discloses an expert system embodiment which includes an application that
14 recommends buy or selling of assets, particularly stocks (see Alden, col. 36, ll. 34+). It would
15 have been obvious for an artisan of ordinary skill at the time of the invention of Edesess to
16 integrate the aforementioned feature of Alden into the Edesess invention because an artisan at
17 the time of the invention would have recognized that the notoriously old and well known
18 method of buying and/or selling stocks/commodities to improve portfolio performance would
19 provide the Edesess system with an alternative of optimizing the investment plan to reach the

1 target scenario. Thus such a modification would have been an obvious expedient to one of
2 ordinary skill in the art.
3

4 **Regarding claims 2 and 16:**

5 Edesess in view of Alden discloses wherein step(d) includes determining tax impacts of
6 potential sell transactions, the recommendations being selected to minimize the tax impacts (see
7 Edesess, col. 5, ll. 38+).
8

9 **Regarding claims 3 and 17:**

10 Edesess in view of Alden discloses wherein the summary report includes tax impacts of
11 at least some of the recommendations (see Edesess, fig. 4 col. 6, ll. 33+).
12

13 **Regarding claims 4 and 18:**

14 Edesess in view of Alden discloses, (f) inputting into a computer data regarding the
15 clients asset portfolio preferences, including current assets that the client wishes to hold or sell,
16 and constraints on asset selling, wherein, step

17 (d) further includes using the data in step (f) to automatically generate the financial
18 transaction recommendations (see Alden, col. 36, ll. 34+).
19

20 **Regarding claims 5 and 19:**

1 Edesess in view of Alden discloses wherein step (d) includes determining transaction
2 costs of potential sell transactions, the recommendations being selected to minimize the
3 transaction costs (see Alden, "Total cost", col. 42, 23+).

4
5 **Regarding claims 6 and 20:**

6 Edesess in view of Alden discloses wherein the summary report includes the transaction
7 costs of at least some of the recommendations (see Alden, "Total cost", col. 42, 23+).

8
9 **Regarding claims 7 and 21:**

10 Edesess in view of Alden discloses wherein the client's current asset portfolio includes
11 repositionable assets, non-repositionable assets and possibly repositionable assets, and step (d)
12 includes a recommendation to hold the client's possibly repositionable assets if the client's new
13 asset location with be within a predetermined percentage of the desired asset allocation after
14 selling all the client's repositionable assets (see Alden, col. 36, ll. 34+).

15
16 **Regarding claims 9 and 23:**

17 Edesess in view of Alden discloses wherein the client's current asset portfolio includes
18 repositionable assets, non-repositionable assets and possibly repositionable assets, and step
19 (d) includes treating the possibly repositionable assets as non-repositionable assets
20 when making the current asset portfolio modifications (see Alden, col. 36, ll. 34+).

1 **Regarding claims 10 and 24:**

2 Edesess in view of Alden discloses wherein the client's current asset portfolio includes
3 repositionable assets, non-repositionable assets and possibly repositionable assets, and step
4 (d) includes a recommendation to sell the client's repositionable asset until the tax
5 cost of selling equals a predetermined percentable of the client's current asset portfolio (see
6 Alden, col. 36, ll. 34+).

7
8
9 **Regarding claims 11 and 25:**

10 Edesess in view of Alden discloses wherein recommendations include
11 recommendations to (I) add specific amounts of shares to currently held mutual funds, and (ii)
12 open one or more new mutual funds and contribute specific amounts of shares to
13 the new funds (see Alden, col. 36, ll. 34+).

14
15
16 **Regarding claims 13 and 27:**

17 Edesess in view of Alden discloses wherein step (d) includes developing target
18 portfolio amounts and adjusted target portfolio amounts for each asset category in the desired
19 asset allocations (see Edesess, fig. 4, col. 6, ll. 33+).

1 **Regarding claims 14 and 28:**

2 Edesess in view of Alden discloses (f) inputting information regarding the client which
3 is necessary to determine the client's desired asset allocation and the client's preferred domain;
4 and

5 (g) automatically determining the client's desired asset allocation and the client's
6 preferred domain and using the results as the data inputs in steps (b) and (c) (see Edesess, col.
7 5, ll. 15+).

8
9 **Regarding claims 29:**

10 Edesess in view of Alden discloses wherein step (e) further comprises communication
11 the specific recommendations for selling amounts of selected current assets and specific
12 recommendations for buying amounts of one or more investment funds to a trade execution
13 computer which automatically performs the necessary transactions to execute the buy/sell
14 recommendations (see Alden, col. 36, ll. 34+).

15
16 6. Claims 30-36, 38-40, 42-50, 51-54 and 56-62 are rejected under 35 U.S.C. 103(a) as
17 being unpatentable over Edesess (US 5,884,287) as modified by Alden (US 5,418,888) as
18 applied to claim 1 above, and further in view of Robinson et al (hereinafter referred to as
19 "Robinson", US 5388,248). The teachings of Edesess as modified by Alden have been
20 discussed above.

1
2 **Regarding claims 30 and 44:**

3 Edesses as modified by Alden fails to disclose computer program product including at
4 least one computer readable medium. Computer readable medium (i.e., IC cards, floppy disks,
5 or compact discs, software packages, etc..) are commonly used in the art to download various
6 computer programs onto computer hard drives for either individual "stand alone" usage, or in
7 conjunction with a network such as the Internet (i.e., American On-line software). Robinson
8 teaches a computer readable medium that has a user programmable memory storage (see
9 Robinson col. 4, ll. 40+). In view of Robinson flash memory card, it would have been
10 obvious for an artisan of ordinary skill at the time of the invention of Edesess as modified by
11 Alden to employ the computer readable medium of Robinson to store the program and to be
12 later downloaded onto a computer system. The computer medium would have provided a
13 convenient means to physically transport software from computer to computer. Thus to provide
14 a computer medium with the aforementioned program would have been an obvious expedient
15 well within the ordinary skill in the art.

16
17 **Regarding claims 31 and 45:**

18 (see explanation for claims 2 and 16)

19
20 **Regarding claims 32 and 46:**

1 see explanation for claims 3 and 17)

2

3 **Regarding claims 33 and 47:**

4 see explanation for claims 4 and 18)

5 **Regarding claims 34 and 48:**

6 see explanation for claims 5 and 19)

7

8

9 **Regarding claims 35 and 49:**

10 see explanation for claims 6 and 20)

11

12 **Regarding claims 36 and 50:**

13 see explanation for claims 7 and 21)

14

15 **Regarding claims 38 and 52:**

16 see explanation for claims 9 and 23)

17

18 **Regarding claims 39 and 53:**

19 see explanation for claims 10 and 24)

20

1 **Regarding claims 40 and 54:**

2 (see explanation for claims 11 and 25)

3
4 **Regarding claims 42 and 56:**

5 (see explanation for claims 13 and 27)

6
7 **Regarding claims 43 and 57:**

8 (see explanation for claims 14 and 28)

9
10 **Regarding claims 58:**

11 (see explanation for claims 29)

12
13 **Regarding claims 59-62:**

14 (see Alden, col. 36, ll. 34+)

Response to Arguments

1
2
3 7. Applicant's arguments filed August 19, 2002 have been fully considered but they are
4 not persuasive. It is respectfully submitted to the applicant that references, in determining
5 obviousness are not read in isolation but for what they fairly teach in combination with the
6 prior art as a whole, and thus patent assignee's reference-by-reference attack on prior art to
7 demonstrate non-obviousness is not persuasive. (Photoelectric sensing system) Banner
8 Engineering v. Tri-Tonics Co. Inc., 29 USPQ 1392 1389 (CAFC 1993 unpub) citing in re
9 Merck, USPQ 375 (CAFC 1986).

10 References are evaluated by what they suggest to one versed in the art, rather than their
11 specific disclosure [see In re Bozek, 163 USPQ 545 (CCPA 1969)]. In this case, the primary
12 reference shows a computerized process and product for automating and executing investment
13 planning for a client, the secondary reference shows an expert system embodiment which
14 includes an application that recommends buy or selling of assets, particularly stocks. The 35
15 USC 103 rejection set forth above provides reasoning for the combinations of references and
16 resolve the level of ordinary skill in the art. In response to applicant's piecemeal analysis of
17 the references, the examiner respectfully submits that one can not show non-obviousness by
18 attacking references individually where, as here, the rejections are based on combinations of
19 references. In regards to applicant's assertion that the primary reference does not teach that
20 specific recommendations are used to reach as close as possible to a desired allocation and/or

1 preferred domain ("asset placement") it is suggested to the applicant to please read the
2 reference again wherein the applicant's invention relates to computer implemented system and
3 method for providing investment optimization *and characterization* (see field of the invention,
4 col. 1, ll. 12-16). In the Summary of the invention the reference addresses applicants assertion
5 of sell recommendations based upon asset allocation and preferred domain factors at least in
6 col. 2, ll. 35 to col. 3, ll. 40, wherein the investment portfolio tax status is taken into
7 consideration (see also col. 5, ll. 15+). An artisan of ordinary skill in the art would
8 understand that the tax status effects the rate of return and thus causes a reallocation in the
9 investment portfolio.

10
11
12 ***Conclusion***

13 8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
14 policy as set forth in 37 CFR 1.136(a).

15 A shortened statutory period for reply to this final action is set to expire THREE
16 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
17 MONTHS of the mailing date of this final action and the advisory action is not mailed until after
18 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
19 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR
20 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,
21 will the statutory period for reply expire later than SIX MONTHS from the mailing date of this
22 final action.

1
2 9. Any inquiry concerning this communication or earlier communications from the examiner
3 should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The
4 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.
5 Any inquiry of a general nature relating to the status of this application or its proceedings should
6 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
7 ***Vincent Millin*** whose telephone number is (703) 308-1065.

8
9 10. Response to this action should be mailed to:

10
11 Commissioner of Patents and Trademarks

12 Washington, D.C. 20231

13
14 for formal communications intended for entry, or (703) 305-0040, for informal or draft
15 communications, please label "Proposed" or "Draft".

16 Communications via Internet e-mail regarding this application, other than those under 35
17 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
18 addressed to [*daniel.felten@uspto.gov*].

19
20
21
22 All Internet e-mail communications will be made of record in the application file. PTO
23 employees do not engage in Internet communications where there exists a possibility that
24 sensitive information could be identified or exchanged unless the record includes a properly
25 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

Serial Number: 09/328,626

Applicant(s): Bove et al. (705/36)

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Art Unit: 3624

Representative: Jablon

1 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
2 Trademark on February 25, 1997 at 1 195 OG 89.

3
4 
5

6 DSF
7 December 2, 2002


HANI M. KAZIMI
PRIMARY EXAMINER